

REMARKS

Applicants thank the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119. The Examiner has alleged, however, that Applicants have not filed a certified copy of the priority document as required by 35 U.S.C. § 119(b). Applicants respectfully submit that a certified copy of the priority document, UK 0226977.37 was filed on July 12, 2004, and attach hereto copies of the transmittal letter, certification and filing receipt date stamped July 12, 2004 by OPIE.

Claim Rejections

Claims 1, 2, 9-11, 14 and 15 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,477,372 to Otting et al. ("Otting"). Applicants traverse this rejection.

In the Examiner's Response to Arguments, the Examiner disagrees with Applicants' position that Otting does not disclose or suggest a method for performing an alternate technology scan, as recited in the rejected claims. The Examiner relies on Figs. 3 and 4 and the disclosure of the specification at column 4, lines 17-38 and column 5, line 50 through column 6, line 32 to refute Applicants' arguments. Applicants respectfully disagree with the Examiner regarding the disclosure of Otting.

At column 4, lines 17-23, Otting states,

"The preferred embodiment of the present invention can be further understood with reference to FIG. 3. *At power up 300, the mobile radiotelephone proceeds to scan 302 for service* in the

multiple radio technologies in which the radiotelephone is capable.

When the mobile has completed its scan, it registers, if necessary, and camps 404 on the best available network. (Emphasis added).

The quotation above clearly discloses that that The mobile unit of Otting initiates and completes an alternate technology scan, but does not disclose details of a method of performing such a scan. The remaining portion of the Otting passage, lines 23-38, describes mobile unit operation after the scan is complete.

Further, at column 5, lines 50-53, Otting states,

“For example, when the [Automatic Technology Scan] feature is “ON”, the mobile radiotelephone itself would detect the presence of a certain GSM network type, and then switch on or off the alternate technology scans appropriately.” Otting then proceeds to describe mobile systems in North America and Europe. At no point, however, does Otting disclose or suggest a method of performing the alternate technology scan. After describing these available systems, Otting continues at column 6, lines 10-16,

“[T]he method of the present invention can be further understood with reference to FIG. 4. ***At power up 400, the mobile radiotelephone proceeds to scan 402 for service*** in the multiple radio technologies in which the radiotelephone is capable. ***When the mobile has completed its scan, it registers, if necessary, and camps 404 on the best available network.***” (Emphasis added).

Clearly, no example is provided of a method for a technology scan, as alleged by the Examiner. The portions of Otting cited by the Examiner merely disclose that the mobile unit of

Otting performs an alternate technology scan, but does not disclose or suggest any details of a manner of performing the scan as recited by the claims.

Since, as established above, Otting does not disclose or suggest a method of performing a technology scan as recited in claims 1, 2, 9-11, 14 and 15, these claims are patentable over Otting, and the § 102(b) rejection should be withdrawn.

Claims 3-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Otting in combination with one of U.S. Patent No. 6,725,041 to Nakano (“Nakano”), U.S. Patent Publication No. 2004/0058679 to Dillinger et al. (“Dillinger”) and U.S. Patent No. 4,670,899 to Brody et al. (“Brody”). Applicants traverse this rejection.

The various combinations of Otting, Nakano, Dillinger and Brody do not disclose or suggest the invention as claimed. As established above, the primary reference, Otting, does not disclose or suggest a method of performing a technology scan. The secondary references, Nakano, Dillinger and Brody, do not cure the deficiencies of Otting. Since claims 3-8 depend from, and incorporate the limitations of, claims 1 or 2, which are patentable over Otting, and since none of Nakano, Dillinger and Brody cure the deficiencies of Otting, claims 3-8 are patentable over the combined references.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 10/714,847

Attorney docket No. Q78522

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

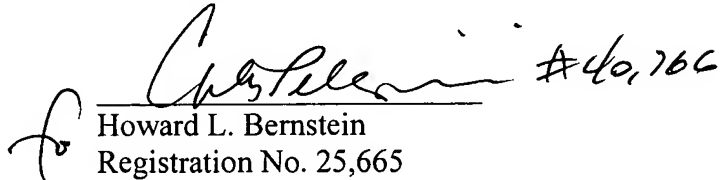
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